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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT PAPER NUMBER

2161

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,755

Applicant(s)

SUBRAMANIAM ET AL.

Examiner

Haythim J. Alaubaidi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,10-13,24,26-30,33-36,47,51,56-59,62,63,72-74,77 and 78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10-13,24,26-30,33-36,47,51,56-59,62,63,72-74,77 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is a **Final Office Action** in response to the amendment of September 03, 2004.
2. Claims 1-92 were originally presented in this Application.
3. The Applicant in the amendment filed on May 10, 2004 canceled claims 2, 8-9, 14-23, 25, 31-32, 37-46, 48-50, 52-55, 60-61, 64-71, 75-76 and 79-92.
4. Claims 1, 3-7, 10-13, 24, 26-30, 33-36, 47, 51, 56-59, 62-63, 72-74 and 77-78 are presented for examination following the amendment of September 03, 2004.
5. Claims 1, 24, 47, 56, 72 are Independent Claims.
6. Claims 1, 24, 56 and 72 stands rejected under 35 U.S.C. 101 including all the claims that depend from the independent claims 1, 24, 56 and 72.
7. Claims 1, 3-7, 10-13, 24, 26-30, 33-36, 47, 51, 56-59, 62-63, 72-74 and 77-78 are rejected under 35 U.S.C. 103(a).

Response to Arguments

8. Applicant's arguments filed in the amendment of September 03, 2004 have been fully considered but they are not persuasive.
 - a. Applicant argues that Mayaud does not disclose the limitation of
"restricting the scope of search based on the first user's organizational identifier, which further includes selecting a subset of data records that match the first user's organizational identifier from a set of records that are associated with the

at least one search category" (Amendment of September 03, 2004, Page 13).

The Examiner however disagrees. Mayaud discloses the above limitation (see Mayaud, Col 10, Lines 11-19, i.e. parts thereof; see also Col 13, Lines 56-63; see also Col 17, Line 60 through Col 18, Line 5, i.e. who or what organization accessed the record, what part of the record was accessed; see also Col 18, Lines 6-23; see also Col 18, Lines 42-52).

b. Applicant argues that there is no motivation to combine Green in view of Byren and further in view of Mayaud (Amendment of September 03, 2004, Page 14). The Examiner however disagrees. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1, 24, 56 and 72 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a

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whole to breathe life and meaning into the preamble. In Bowman (Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter.

Although Bowman discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, independent claims 1, 24, 56 and 72 recite limitations in the claimed language that is not within a technological art and every limitation of the claimed language can be done by a person's mind or through a paper process. In other words for example,

- *"receiving a search request containing search criteria from a first user, wherein the search criteria includes at least one search category"* the Examiner can interpret this limitation to be similar to a person requesting another person (by speech or by a written request) to search for certain information in a file cabinet for example (no indication to any computer related search or a computerized method);
- *"determining the first user's organizational identifier"* similar to checking the person's ID or badge;
- *"performing a search based on the search criteria"* searching through the file cabinet, *"to identify records that matches the search criteria"* looking for the requested paper document that matches a certain criteria, *"and to which the first user is*

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allowed to access" by permitting this person with this badge ID to search this file cabinet only, ...etc.

The Examiner respectfully would like to direct the Applicant attention to the fact that the claim language specify no technology art such as for example, a computer processor; and since the claimed language is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter.

Claims 3-7 and 10-13 that depends from Independent Claim 1; Claims 26-30 and 33-36 that depends from Independent Claim 24; Claim 51 that depends from Independent Claim 47; Claims 57-59 and 62-63 that depends from Independent Claim 56; and Claims 73-74 and 77-78 that depends from Independent Claim 72, inherent the deficiencies of the independent claims. They are therefor rejected as set forth above.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1, 3-7, 10-13, 24, 26-30, 33-36, 47, 51, 56-59, 62-63, 72-74 and 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable by Gordon M. Green (U.S. Patent No. 6,449,598 and Green hereinafter) in view of Debora J. Byrne (U.S. Patent No. 6,490,619 and Byrne hereinafter) and further in view of Christian Mayaud (U.S. Patent No. 5,845,255 and Mayaud hereinafter).

Regarding Claims 1, 13, 24, 47, 56, 72 and 78 Green discloses receiving a search request of search criteria (Col 2, Lines 15-17, i.e. A user can quickly access the set of policies for which he is responsible, or the set of policies which meet the user's search criteria; see also Col 7, Lines 42-46) wherein the search criteria includes at least one search category (Col 5, Line 54 through Col 6, Line 2);

determining the first user's organizational identifier (Col 6, Lines 3-15, i.e. user attributes; see also defining a department); and

performing a search based on the search criteria (Col 4, Lines 48-63) to identify records that matches the search criteria and to which the first user is allowed to access (Col 7, Lines 8-13, i.e. and the document becomes available to qualified users for searches and display. The document can be located through the "search" and "browse" functions and is automatically included in the list of required policies for the appropriate users).

Green's reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the search based on the first user's organizational

identifier. However Byrne teaches searching based on the first user's organizational identifier (Byrne, Abstract; see also Col 8, Lines 17-29).

Given the intended broad application of the Green's system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Green with the teachings of Byrne to add another attribute (organization based attribute) when conducting a search for data. Green provide access restriction to data that are sensitive or need not to be access by other groups; however the reference does not base this restriction on the organization which the user belongs to. Byrne however provides access control based on the user organization and the organization unit also. It would be obvious to combine both features of the references to maximize the flexibility of Greens system when adding another attribute, such as, the user organization; another reason would be to increase access to certain data relating to certain user organization if the search was based on the user organization.

The combination of bother Green and Byrne discloses all of the claimed subject matter set forth above, except they don't explicitly indicate wherein performing the search includes restricting the scope of search based on the first user's organizational identifier, which further includes selecting a subset of data records that match the first user's organizational identifier from a set of records that are associated with the at least one search category. However Mayaud teaches wherein performing the search includes restricting the scope of search based on the first user's organizational identifier which further includes selecting a subset of data records that match the first user's organizational identifier from a set of records that are associated with the at least one

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search category (Mayaud, Col 10, Lines 11-19, i.e. parts thereof; see also Col 13, Lines 56-63; see also Col 17, Line 60 through Col 18, Line 5, i.e. who or what organization accessed the record, what part of the record was accessed; see also Col 18, Lines 6-23; see also Col 18, Lines 42-52).

Given the intended broad application of both Green and Byrne, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of both Green and Byrne with the teachings of Mayaud to include this common database feature of access level to records, one reason would be to maintain privacy of some records, such as private information or sensitive information while at the same time allowing access to other records that may not contain sensitive information.

Regarding Claims 3, 26 and 58, Green discloses keyword searching (Col 7, Lines 47-48, i.e. focused by the specified search criteria, a search is done for documents with matching keywords).

Regarding Claims 4-5 and 27-28, Green discloses associating a search category with a search index and then with a business component (Col 5, Line 54 through Col 6, Line 2, i.e. and a category hierarchy [index] is created; see also institution [business component]).

Regarding Claims 6 and 29, Green discloses wherein the business component is a database table (Col 5, Lines 54-56; see also Col 13, Lines 40-44).

Regarding Claims 7 and 30, Green discloses an interface (Col 7, Line 24; see also Line 32, i.e. automated searches; see also Line 42, i.e. choosing criteria; see also Col 11, Lines 49-59, i.e. search screen).

Regarding Claims 10-11, 33-34, 51, 62-63 and 77, the limitations of these claims are similar in scope to the rejected claims 1 and 3, above. They are therefore rejected as set forth above.

Regarding Claims 12 and 35, Green discloses structured query language (figures 10 and 11); see also Byrne, (Col 1, Lines 62-67 and Col 2, Lines 24-31).

Regarding Claim 36, the limitations of this claim are similar to Claim 1 and 13, above, which was rejected earlier. In edition Green discloses displaying the search results (Col 11, Lines 56-57).

Regarding Claims 57, Green discloses category searching (Col 4, Lines 36, i.e. The stored document selecting means includes means for locating documents based on the stored document categories).

Regarding Claims 59 and 74, Green discloses:

determining a list of users group to which the first user belongs (Col 14, Lines 27-29); and

determining one or more specific categories that are associated with the respective user group (Col 14, Lines 23-26).

Regarding Claim 73, the limitations of this claim is similar in scope to the rejected claims 2 and 3, above. It is therefore rejected as set forth above.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Points of Contact

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered responses should be brought to the Customer Service Window of the Randolph Building at 401 Dulany Street, Alexandria, VA 22314

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
Art Unit 2161
March 18, 2005

Frantz Coby
FRANTZ COBY
PRIMARY EXAMINER